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**C. REMARKS****Status of the Claims**

Claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 are currently present in the Application, and claims 1, 18, and 28 are independent claims. Claims 28, 30, 32, 33, 35, and 37 have been amended, no claims have been cancelled, and no claims have been added.

**Claim Rejections Under 35 U.S.C. § 101**

Claims 28, 30-33, 35, 37, and 40 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejections under 35 U.S.C. § 101.

The Examiner recites a two-prong test for determining whether a claim is statutory under 35 U.S.C. § 101, including 1. whether the invention is within the technological arts, and 2. whether the invention produces a useful, concrete, and tangible result. The Examiner admits that Applicants' claims produce a tangible result, but then states that the claims are non-statutory because the "computer program product is not embodied on a tangible medium" (see Office Action, page 3, lines 3-12). As an initial matter, Applicants note that the Board of Patent Appeals and Interferences has recently found that there is no separate "technological arts" test in determining whether a process is statutory subject matter (*Ex Parte Lundgren*). Therefore, as long as Applicants' claims produce a useful, concrete, and tangible result, which the Examiner has admitted is the case, they are statutory subject matter.

However, in the interest of being as clear as possible, Applicants have amended the computer program product claims to clarify that the computer program product is stored in a computer operable media and contains instructions, which, when executed by a computer, cause the computer to perform a method for handling travel arrangements.

Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 101.

**Claim Rejections - Alleged Anticipation Under 35 U.S.C. § 102**

Claims 1, 3, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Flake et al., U.S. Patent No. 5,832,451 (hereinafter Flake). Applicants respectfully traverse the rejections under 35 U.S.C. § 102.

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**Rodriguez, et. al. - 09/704,569**

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Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Abstract). Flake is a travel service management information system that uses a database to store data that may be useful when making travel reservations for a customer. For example, a business entity profile and/or user profile may be used by a travel agent when processing a customer's travel request (see Abstract).

Applicants teach and claim a method, system, and computer program product for performing various automated tasks based upon a user's travel arrangements, such as cancelling a user's mail delivery and/or changing voice mail messages. Using independent claim 1 as an exemplary claim, Applicants teach and claim the following:

- scheduling the travel arrangements using a computer system;
- recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and
- sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

Applicants respectfully submit that Flake does not teach, or even suggest, "sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile," as taught and claimed by Applicants. A close reading of Flake does not reveal any *sending* of any type of *automated request* corresponding to travel arrangements. There is no sending of any type of automated request *from the computer system on which travel arrangements were made to a service agent*. Further, there are no *automated requests based on*

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*a user's travel profile.* In short, Flake fails to teach or suggest anything having to do with this element of Applicants' independent claims.

The Examiner cites Flake at col. 2, lines 19-24 and col. 3, lines 42-48. These citations are reproduced below:

In response to a customer's travel request, the system automatically retrieves, and displays for decision-making by an agent, all pertinent information retrieved from the customer's business entity profile and/or individual profile, and the appropriate computer reservation system(s). (Flake, col. 2, lines 19-24).

One or more travel agency customers 16 can communicate with one or more travel agents via any one of a number of communications subsystems 17. Each communications subsystem 17 preferably functions to provide two-way communications between a customer and an agent. For example, one such communications subsystem may be a telephone system, a second such subsystem may be a facsimile machine, and a third such subsystem may be a computer-driven system providing E-mail communications. Travel service request information from a customer is preferably input as data to system 10, by an agent. (Flake, col. 3, lines 42-52).

The cited portion of Flake at col. 2, lines 19-24, discloses that a computer system retrieves a business entity profile and/or individual profile, so that a travel agent has this information available when making travel reservations for a customer. The individual entity profiles disclosed by Flake pertain to "an individual customer's personal information and travel preferences, such as, for example, the customer's name and address, employer, seating preference, smoking or non-smoking preference, a list of preferred vendors (e.g., airlines), etc." (col. 3, line 65 through col. 4, line 3). Individual entity profiles are used by a travel agent to assist in making travel reservations for a customer (see Abstract, lines 7-10). These individual entity profiles are not used as a basis for sending automated requests from the computer system that schedules the travel arrangements to one or more service agents, as taught and claimed by Applicants. Importantly, Flake does not mention of any type of "automated request" being

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generated, and certainly, no “automated request” that is sent *from* the computer system on which the travel arrangements are made *to* “one or more service agents” as taught and claimed by Applicants. Flake merely discloses that when a customer wants to make travel reservations, the travel agent’s computer system automatically retrieves the customer’s user profile in order to assist the travel agent in making the reservations. In contrast, Applicants teach and claim that travel arrangements are scheduled and stored, and an automated request, corresponding to the travel arrangements, is sent from the computer system on which the travel arrangements were scheduled to one or more service agents.

Flake discloses that a computer system “automatically retrieves” a business profile or individual profile. This is simply not the same as generating an “automated request,” as taught and claimed by Applicants. The “automated requests” claimed by Applicants are “*based on a traveler’s user profile,*” but they are not identical to the traveler’s user profile. In Flake, the traveler’s user profile is automatically retrieved. However, this is not analogous to *sending an automated request that is based on a user’s profile*, as taught and claimed by Applicants. In other words, Applicants do not claim automatically retrieving a traveler’s user profile, which is what it is disclosed by Flake. Rather, Applicants claim sending an automated request that is based on the traveler’s user profile from the computer on which the travel arrangements were made to a service agent.

It is important to further note that Applicants are not claiming that *the customer’s travel request* is based on the customer profile information. Rather, Applicants are claiming that “automated requests corresponding to the travel arrangements,” i.e. *the travel arrangements that are scheduled* using the computer system, are sent “from the computer system to one or more service agents.” It is these automated requests that are “based on a traveler’s user profile.” Flake does not teach or suggest that “*the automated requests* are based on a traveler’s user profile” as taught and claimed by Applicants. Rather, Flake discloses that a customer’s travel request may be processed automatically, rather than by a travel agent (col. 5, lines 9-12). In other words, Flake is concerned with a customer’s request to schedule travel arrangements. Flake does not teach or suggest any automated requests that are sent *from* the computer system that schedules the travel arrangements *to* a service agent, which is what Applicants teach and claim in independent claims 1, 18, and 28.

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The cited portion of Flake at col. 3, lines 42-48 (note that lines 42-52 are quoted above) discloses that a customer can communicate with a travel agent using a telephone, a FAX machine, or e-mail. The travel service request information that is sent from the customer to the travel agent, via telephone, FAX, or e-mail, is then "input as data to system 10, by an agent" (col. 3, lines 50-52). Receiving information from a customer over the telephone (or via FAX or e-mail) is not the same as sending an automated request corresponding to the travel arrangements from the computer system on which the travel arrangements were scheduled to a telephone system service agent. Flake is simply stating that a customer and a travel agent can talk to each other on the telephone. There is absolutely no teaching of sending any type of automated request to a telephone system, or any other type of service agent. Flake simply does not teach, or even suggest, "sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile," as taught and claimed by Applicants in independent claim 1, 18, and 28.

For the reasons set forth above, Applicants respectfully submit that independent claims 1, 18, and 28, and the claims which depend from, them are not anticipated by Flake, and respectfully request that they be allowed.

**Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103**

Claims 25, 35, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Gershman et al., U.S. Patent No. 6,401,085 (hereinafter Gershman). Claims 4-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Levine, U.S. Patent No. 6,076,121 (hereinafter Levine). Claims 14, 15, 27, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Berman et al., U.S. Patent No. 5,995,939 (hereinafter Berman). Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Felger, U.S. Patent No. 6,553,108 (hereinafter Felger). Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a).

**1. Claims 25, 35, And 41 Are Patentable Over Flake In View Of Gershman**

Claims 25, 35, and 41 depend from independent claims 18, 28, and 1, respectively, and are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

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Using claim 41 as an exemplary claim, claims 25, 35, and 41 add the following elements:

- receiving the automated request at the electronic calendar system; and
- updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.

The Examiner cites Flake at col. 20, line 55 as disclosing that a processor is operable to receive a travel request from a customer. However, the "automated request" claimed by Applicants is an automated request that 1. corresponds to the travel arrangements, 2. is based on the traveler's user profile, and 3. is sent from the computer system on which the travel arrangements are made to one or more service agents. As discussed fully above, Flake does not teach, or even suggest, an automated request as taught and claimed by Applicants in independent claims 1, 18, and 28 (and from which claims 25, 35, and 41 depend).

Gershman purports to teach the use of a wireless device with Internet Protocol capabilities to provide a portable portal into the Internet (see Abstract). Applicants respectfully submit that Gershman does not teach or suggest "receiving the automated request at the electronic calendar system," and then "updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements," as taught and claimed by Applicants. The Examiner cites Gershman at col. 10, lines 62-65 and col. 11, lines 15-18 as disclosing these aspects of Applicants' claims. Column 10, line 62 through column 11, line 21 of Gershman is reproduced below:

In accordance with a preferred embodiment, BackgroundFinder (BF) is implemented as an agent responsible for preparing an individual for an upcoming meeting by helping him/her retrieve relevant information about the meeting from various sources. BF receives input text in character form indicative of the target meeting. The input text is generated in accordance with a preferred embodiment by a calendar program that includes the time of the meeting. As the time of the meeting approaches, the calendar program is queried to obtain the text of the target event and that information is utilized as input to the agent. Then, the agent parses the input meeting text to extract its various components such as title, body, participants, location, time etc. The system also performs pattern matching to identify particular meeting fields in a meeting text. This information is utilized to query various sources of information on the web and obtain relevant stories

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about the current meeting to send back to the calendaring system. For example, if an individual has a meeting with Netscape and Microsoft to talk about their disputes, and would obtain this initial information from the calendaring system. It will then parse out the text to realize that the companies in the meeting are "Netscape" and "Microsoft" and the topic is "disputes." Then, the system queries the web for relevant information concerning the topic. Thus, in accordance with an objective of the invention, the system updates the calendaring system and eventually the user with the best information it can gather to prepare the user for the target meeting. In accordance with a preferred embodiment, the information is stored in a file that is obtained via selection from a link imbedded in the calendar system.

Gershman appears to disclose an agent, i.e. BackgroundFinder (BF), that helps an individual prepare for a meeting. The BF agent receives input text from a calendar program that indicates the time of the meeting, along with other information, such as the title, body, participants, location, etc. Using this information, BF queries various sources of information on the web to obtain information about the meeting. This information is stored in a file that can be selected from a link in the calendar system.

Gershman does not appear to have anything to do with receiving an automated request at an electronic calendar system, as taught and claimed by Applicants. Keep in mind that the "automated request" claimed by Applicants is defined in the independent claims as being an automated request "corresponding to the travel arrangements" and "based on a traveler's user profile." As further defined by the independent claims, the "automated request" claimed by Applicants is sent "from the computer system" on which the travel arrangements were scheduled. Gershman does not teach, or even suggest, receiving such an automated request at an electronic calendar system, as taught and claimed by Applicants.

Gershman also does not teach or suggest "updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements," as taught and claimed by Applicants. Although Gershman may update a calendar system with information pertaining to an upcoming meeting, Gershman does not update an electronic calendar with information related to the travel arrangements, as taught and claimed by Applicants. Although the Examiner further cites Gershman at col. 45, lines 48-56, Applicants are unclear as to the relevance of this portion of Gershman. The cited section of Gershman appears to be discussing a "daily logistics display" on which a user may "select from various activities based on requirements, including travel 2110, household chores 2120, finances 2130 and marketplace

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activities 2140" (col. 45, lines 50-52). There does not appear to be any discussion of "updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements" as taught and claimed by Applicants. Rather, this section of Gershman simply appears to be pointing out various options on a daily logistics display.

Neither Flake, nor Gershman, nor a combination of the two teaches or suggests Applicants' invention as claimed. For the reasons set forth above, Applicants respectfully submit that claims 25, 35, and 41 are patentable over Flake in view of Gershman, and respectfully request that they be allowed.

2. Claims 4-10, 21-23, And 31-33 Are Patentable Over Flake In View Of Levine

a. There Is No Motivation To Combine Flake And Levine

MPEP § 706.02(j) states, inter alia:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2143.01 states, inter alia (emphasis added):

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).



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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Regarding the references used by the Examiner to support the rejection of claims 4-10, 21-23, and 31-33, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). In general, Levine teaches a system and method to minimize the number of directory numbers (i.e. telephone numbers) that a user requires. Specifically, Levine teaches addressing and translating addresses in a network by adding a functional property code to each device a user employs (see Levine, Abstract). Levine's functional property codes are used to distinguish a device's "type," such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code (see Levine, Abstract). Applicants respectfully submit that there is no motivation to combine the

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teachings of Flake with the teachings of Levine, as this would add unnecessary complexity to Flake's travel service management information system. There does not appear to be any need for a functional property code in Flake as the travel information requests are sent over an existing network, where both the sending and receiving end of the network are configured to communicate with each other, and do not appear to require any specification of "device type" in order to communicate.

It appears that the Examiner improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the Examiner used impermissible hindsight in combining Flake and Levine in order to support a rejection of Applicants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Applicants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the network addressing and translation system of Levine with the travel service management information system of Flake would result in a workable solution without relying on Applicants' disclosure. Thus, Applicants contend that the Examiner used impermissible hindsight in rejecting Applicants' claims.

For the reasons set forth above, Applicants respectfully submit that claims 4-10, 21-23, and 31-33 are not obvious, and are therefore patentable over Flake in view of Levine.

**b. Flake And Levine Do Not Teach Or Suggest Claims 4-10, 21-23, And 31-33**

Claims 4-10, 21-23, and 31-33 each depend, either directly or ultimately, from one of Applicants' independent claims, and are therefore patentable for at least the reasons discussed above with regard to Applicants' independent claims. Claims 4-10, 21-23, and 31-33 add further limitations regarding various types of service agents and automated requests.

Claim 4 adds the elements of "wherein the delivery service agents include one or more parcel services, and wherein the automated requests include one of holding packages for

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customer pickup, delivering packages on a future date, and leaving packages with a neighbor." Claim 5 adds the elements of "wherein the delivery service agent includes a post office, and wherein the automated requests include at least one of holding mail for customer pickup, delivering mail on a future date, and forwarding mail to another address." Claim 6 adds the elements of "wherein the delivery service agent includes a company mailroom, and wherein the automated requests include at least one of holding mail for future pickup, delivering mail on a future date, and forwarding mail to another address." Claims 21 and 31 add the elements of "wherein the automated requests include at least one of holding packages for future pickup, delivering packages on a future date, and leaving packages at an alternate location."

The Examiner cites Levine at col. 2, lines 8-14, 14-17, and 28 as disclosing these elements of Applicants' claims. However, the cited sections of Levine are in Levine's background section, and are describing a method of determining which physical path to use, i.e. which roads to use, to deliver a parcel. The cited section of Levine reads as follows (emphasis added):

"A mail or parcel system is a simple network. Each resident has a resident address and each business has a corresponding business address, where an address serves as an origin point (the return address) or destination point (the location the item is addressed to). *The links are the roads* and other transportation routes that make the delivery of the mailed items possible. The post offices and parcel handling offices serve as transit point nodes – sorting mail or parcels and directing it to appropriate links for delivery to designated DPs.

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Provided the DP is legible and meets certain criteria of the network, the office sorts the item according to the link or series of links which optimize the delivery of the item."

The cited section of Levine does not mention anything about automated requests, and certainly does not teach or suggest the various types of automated requests as taught and claimed by Applicants in claims 4-6, 21, and 31. Levine is simply describing a prior art system for determining how best to route parcels *over the road system* from one point to another. Therefore, Applicants respectfully submit that claims 4-6, 21, and 31 are patentable over Tognazzini in view of Flake and Levine.

Using claim 7 as an exemplary claim, claims 7, 22, and 32 include the additional limitation of "wherein sending automated requests include configuring instructions

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corresponding to a telephone.” The Examiner cites Levine at col. 8, lines 45-47 and col. 12, lines 20-35 as disclosing this aspect of Applicants’ invention. However, as discussed above, Levine is concerned with “transporting an item between points within the network” (Levine, col. 8, lines 30-32). The network may be a telephone network, as disclosed in col. 8, lines 45-47. Levine teaches addressing and translating addresses in a network by adding a functional property (FP) code to each device a user employs (see Abstract). Levine’s functional property codes are used to distinguish a device’s “type,” such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device’s functional property code (see Abstract).

The cited section of Levine, i.e. col. 12, lines 20-35, appears to be describing various ways in which a user may enter and modify FP codes. Assigning an FP code to a device is not the same as “sending automated requests” including “*configuring instructions* corresponding to a telephone,” as taught and claimed by Applicants. Levine is not concerned with configuring the telephone itself, but, rather, with assigning a functional property code to the telephone (or other device), so that the FP code can be used at a later point in time to route items between points within the network. As further claimed by Applicants in claims 8-10, 23, and 33, the configuring may include registering the telephone with an e-mail system, changing a voicemail greeting, etc. There is nothing in Levine that discloses this type of configuring. Rather, Levine allows an FP code to be assigned to a telephone or other device. Levine does not teach or suggest “sending automated requests” including “*configuring instructions* corresponding to a telephone,” as taught and claimed by Applicants. Therefore, Applicants respectfully submit that claims 7-10, 22, 23, 32, and 33 are patentable over Flake in view of Levine.

For the reasons set forth above, Applicants respectfully submit that claims 4-10, 21-23, and 31-33 are patentable over Flake in view of Levine, and respectfully request that they be allowed.

**3. Claims 14, 15, 27, And 37 Are Patentable Over Flake In View Of Berman**

**a. There Is No Motivation To Combine Flake And Berman**

Applicants respectfully submit that there is no motivation to combine Berman with Flake. Berman purports to teach that service requests, such as ordering a medical test or requesting authorization for a particular procedure, are prepared and e-mailed to the sponsor system of an

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appropriate service provider. The request is fulfilled and the results e-mailed back (see, Abstract). Berman further states that "a complete system . . . typically includes hundreds of client systems and dozens of sponsor system" (col. 2, lines 53-55), and "requires that a database of information, such as the identities of a roster of patients, be built up on the client system" (col. 3, lines 6-8).

Berman's automated network service request and fulfillment system is targeted toward the health care industry, such as a doctor's office for ordering a specific blood test (col. 4, lines 4-9). In contrast, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). Therefore, Applicants respectfully submit that there is no motivation to combine the teachings of Berman, which has to do with the medical industry, with the teachings of Flake, which has to do with managing travel service information.

Once again, it appears that the Examiner improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the Examiner used impermissible hindsight in combining Flake and Berman in order to support a rejection of Applicants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Applicants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the automated network service request and fulfillment system of Berman with the travel service management information system of Flake would result in a workable solution without relying on Applicants' disclosure. Thus, Applicants contend that the Examiner used impermissible hindsight in rejecting Applicants' claims.

For the reasons set forth above, Applicants respectfully submit that claims 14, 15, 27, and 37 are not obvious, and are therefore patentable over Flake in view of Berman.

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b. Flake And Berman Do Not Teach Or Suggest Claims 14, 15, 27, And 37

Claim 14 depends from independent claim 1, and claim 15 depends from claim 14. Claim 27 depends from independent claim 18, and claim 37 depends from independent claim 28. Therefore, claims 14, 15, 27, and 37 are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

Claim 14 further includes the limitations of "receiving the automated request at the medical information system," and "downloading destination related medical information to a computing device that is accessible by a user in response to the received request." The Examiner cites Berman at col. 3, lines 64-47 and col. 12, lines 24-35 as disclosing these elements of Applicants' claims. Keep in mind that claim 14 depends from claim 1, which specifically claims sending "automated requests corresponding to the travel arrangements," and further claims that "the automated requests are based on a traveler's user profile." The sections of Berman cited by the Examiner do not have anything to do with travel-related automated requests as taught and claimed by Applicants. Further, the section of Berman cited at col. 12, lines 24-35 is part of Berman's claim 17 that reads as follows:

17. The system of claim 1, wherein each of said service requests is fulfilled by a known one of a plurality of said sponsor systems, said client system further comprising a database of e-mail addresses for said sponsor systems and further programmed to automatically retrieve the e-mail address from said database for the sponsor system which fulfills the service request for which said retrieved service request screen is pre-formatted, and to use said retrieved e-mail address when e-mailing said service request message through said client system's network communication interface and over said computer network to said remote sponsor mailbox.

The Examiner cites Berman's claim 17 as teaching "downloading destination related medical information to a computing device that is accessible by a user in response to the received request." Applicants are at a loss to understand how Berman's claim 17, which appears to claim retrieving the e-mail address of a sponsoring system, has anything to do with downloading destination related medical information in response to receiving a travel related automated request.

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Because Berman does not teach or suggest either of the elements claimed by Applicants in claim 14, Applicants respectfully submit that claim 14, and claim 15, which depends from claim 14, are patentable over Flake in view of Berman.

Regarding claims 27 and 37, the Examiner cites Flake as disclosing "means for receiving the *automated request* at a second information handling system." However, as discussed in detail above, Flake does not teach or suggest an automated request corresponding to travel arrangements, where the automated request is based on a traveler's user profile and is sent from the computer on which travel arrangements were scheduled to one or more service agents. The Examiner further cites Berman as disclosing "means for downloading destination related medical information . . ." As discussed above, Berman does not teach or suggest this element of Applicants' claims. Because neither Flake nor Berman teaches or suggest the elements claimed by Applicants in claims 27 and 37, Applicants respectfully request that claims 27 and 37 be allowed.

For the reasons set forth above, Applicants respectfully submit that claims 14, 15, 27, and 37 are patentable over Flake in view of Berman, and respectfully request that they be allowed.

#### 4. Claims 38-40 Are Patentable Over Flake In View Of Felger

##### a. There Is No Motivation To Combine Flake And Felger

Applicants respectfully submit that there is no motivation to combine Felger with Flake. Felger purports to teach a method for billing a communication session between a user and a value-added service (see Felger, Abstract). The communication sessions discussed in Felger include circuit-switched calls, computer-network telephony calls, and multimedia sessions. In contrast, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). Therefore, Applicants respectfully submit that there is no motivation to combine the teachings of Felger, which has to do with billing for communications sessions, with the teachings of Flake, which has to do with managing travel service information.

Once again, it appears that the Examiner improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the Examiner used impermissible hindsight in combining Flake and Felger in order to support a rejection of Applicants' claims.

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As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Applicants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the billing system of Felger with the travel service management information system of Flake would result in a workable solution without relying on Applicants' disclosure. Thus, Applicants contend that the Examiner used impermissible hindsight in rejecting Applicants' claims.

For the reasons set forth above, Applicants respectfully submit that claims 38-40 are not obvious, and are therefore patentable over Flake in view of Felger.

b. Flake And Felger Do Not Teach Or Suggest Claims 38-40

Claim 38 depends from independent claim 1, claim 39 depends from independent claim 18, and claim 40 depends from independent claim 28. Thus, claims 38-40 are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

Using claim 38 as an exemplary claim, claims 38-40 add the element of "wherein one of the automated requests results in increasing a user's electronic wallet balance and decreasing a user's bank account balance, the user corresponding to the travel arrangements." The Examiner cites Felger's Abstract and also Felger at col. 13, lines 61-66 as disclosing this aspect of Applicants' claims. In claims 38-40, Applicants claim a method, system, and computer program product for "increasing a user's electronic wallet balance and decreasing a user's bank account balance" as one of many possible *travel-related automatic requests*. Note that claims 38-40 each depend from an independent claim that specifically claims "automated requests corresponding to the travel arrangements," and further claims that "the automated requests are based on a traveler's user profile." Felger is concerned with billing for communication sessions, and not with automated requests pertaining to travel arrangements, as taught and claimed by Applicants. Felger does not teach or suggest that *a travel-related automatic request* increases a user's electronic wallet balance and decreases a user's bank account balance, as taught and



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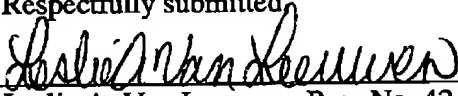
claimed by Applicants. Therefore, Applicants respectfully submit that claims 38-40 are patentable over Flake in view of Felger.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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